

REMARKS

In accordance with the foregoing, claims 3-9, 12-20, 23-31, 43, 45, and 46 are pending and under consideration.

ALLOWABLE SUBJECT MATTER

Applicants acknowledge with appreciation that claim 43 is allowed.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 3, 12, 23, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over mIRC v3.7 and further in view of IBM TDB "Information Skimmer Utility", v.36 no. 08 August 1993 ("IBM TDB"), and U.S. Patent No. 5,903,870 to Kaufman ("Kaufman"). Claims 3, 12, 23, 45, and 46, are independent claims. The Office Action does not formulate separate arguments directed to each of the independent claims. Therefore, Applicants respond to the argument while referring to claim 3, and then specify the features of the other independent claims not disclosed by the cited prior art.

Claim 3 is directed to a display method for a chat system.

The outstanding Office Action submits¹ that primary prior art reference, mIRC v3.7, does not teach or suggest "determining whether the keyword exists in a conversation and in a response carried out using the chat system" as recited in claim 3. The Office Action then alleges that "the user ability to scan for information matched keywords defined by the user" disclosed in IBM TDB teaches or suggests this missing feature. However, IBM TDB's teachings are remote from the feature recited in claim 3 at least because IBM TDB searches words from a search dictionary, and the search described in IBM TDB is performed only in an already existing text and not forward looking, to signal if the input word occurs in an on-going conversation as recited in claim 3 (i.e., "returning to a display of a conversation when said keyword is received..."). Therefore, Applicants respectfully submit that only by using improper hindsight and by adding features not disclosed by either of the references (mIRC v3.7 and IBM TDB) would a person skilled in the art have been led to make the display method for a chat system recited in claim 3.

The outstanding Office Action also submits² that primary prior art references, mIRC v3.7 and IBM TDB, do not teach or suggest "returning to a display of a conversation when said keyword is received while the conversation is not displayed, and emphasizing said keyword" as recited in claim 3. The Office Action then relies on Kaufman to teach or suggest the missing

¹ See the Office Action mailed March 22, 2007, Page 3, line 5.

features. Kaufman describes an apparatus comprising a speech transducer, a processor and a display device. The indicated portions of Kaufman refer to a command and programming language which allow handling and customizing the windows on the display. The processor modifies the windows based on the speech signals received from the speech transducer. In contrast to Kaufman, in claim 3, focusing (returning to) a display is not the result of a user's action (i.e. speech signals), but it is triggered by the occurrence of the input word in an on-going conversation.

Applicants respectfully submit that one of ordinary skill in the art would not have combined the teachings of mIRC v3.7 with the teachings of IBM TDB and Kaufman because these disparate teachings raise a question of why the artisan would even consider these references for combination, a question the PTO must answer. See *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), requiring the PTO to "explain the reasons one of ordinary skill in the art would have been motivated to select the references" The position that the chat system disclosed in mIRC v3.7 can be modified to arrive at the claimed method is insufficient to establish a *prima facie* case of obviousness.³ In rejecting a claim under 35 U.S.C. §103(a), the USPTO must support its rejection by "substantial evidence" within the record,⁴ and by "clear and particular" evidence⁵ of a suggestion, teaching, or motivation to combine the teachings of different references. In this case, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying mIRC v3.7 by incorporating features of IBM TDB and Kaufman. The mere recitation of the advantages of the current invention, do not support the combination of the different references. Reciting the advantages of the claimed invention which are not a linear combination, but a synergetic result, as the only motivation for the combination, signals hindsight reconstruction.

Claims 4-9, 13-20, and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable

² See, the Office Action mailed March 22, 2007, Page 3, line 11.

³See MPEP 2143.01 stating that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness"; see also same section stating "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,'" (citation omitted).

⁴ *In re Gartside*, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

⁵ *In re Dembiczak*, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although [the suggestion more often comes from the teachings of the pertinent references.] The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular." (emphasis added).

over mIRC v3.7 and Kaufman in view of U.S. Patent No. 5,838,323 to Rose et al. ("Rose"). Rose does not correct or compensate for the above-identified failure of the cited prior art references to teach or suggest all the features and make a proper combination.

Therefore, claim 3 and claims 4-9 depending from claim 3 are believed to be non-obvious and patentable over the applied prior art.

Claim 12 is patentable at least by reciting "sending and receiving conversations in plural chat channels", "determining whether the keyword exists in a conversation and in a response carried out using one of the plural chat channels", "displaying said keyword in bold type or generating a specified sound when said set keyword exists and the conversation is displayed" and "returning to a display of a conversation when said keyword is received while the conversation is not displayed." Claims 13-20 depending from claim 12 are also patentable at least by inheriting patentable features from claim 12 from which they depend.

Claim 23 is patentable over the cited prior art by reciting "determine whether the keyword exists in a conversation" (from conversations in plural channels), "display said keyword in bold type or generate a specified sound when said set keyword exists in a displayed conversation" and "return to a display of a conversation when said keyword is received while the conversation is not displayed." Claims 24-31 are also patentable at least by inheriting patentable features from independent claim 23 from which they depend directly or indirectly.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

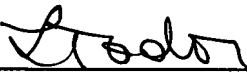
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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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